



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,982	12/27/2000	Yoriko Azuma	0033-0684P	3639
7590	09/28/2004		EXAMINER	
BIRCH, STEWART, KOLASCH & BIRCH, LLP			DURAN, ARTHUR D	
P.O. Box 747			ART UNIT	PAPER NUMBER
Falls Church, VA 22040-0747			3622	

DATE MAILED: 09/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/747,982	AZUMA, YORIKO <i>56</i>
	Examiner	Art Unit
	Arthur Duran	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 June 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,3-5 and 8-20 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1, 3-5, 8-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/27/00.

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

1. Claims 1, 3-5, 8-20 have been examined.

Response to Amendment

2. The Amendment filed on 6/28/04 is insufficient to overcome the Goldhaber reference.

Claim Objections

3. Claim 16 objected to because of the following informalities. Claim 16 is stated as dependent upon claim 7, however, claim 7 is cancelled. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-5, 8-9, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber (5,794,210).

Goldhaber et al teaches an electronic advertisement receiving apparatus comprising electronic advertisement receiving means (col. 5, lines 50-55, col. 9, lines 60-67); presenting means for presenting the advertisement (col. 9, lines 40-50, fig. 11); and presentation informing means for informing the advertiser of presentation information (col. 7, lines 55-67, col. 17, lines 30-40). Goldhaber also teaches uniquely identifying the advertisement and storage control

means for storing the advertisement if it does not match an ad that is already stored (col. 16, lines 25-40); including benefit information from the advertiser to the user in return for presentation of the advertisement (col. 5, lines 25-45); the benefits are updated according to the number of times the advertisement is presented (one time, for example, col. 17, lines 45-55); procedure information representing a procedure for generating presentation information while updating benefits and advertisement receiving apparatus comprises presentation information generating means (col. 7, lines 45-65); validity confirming means for confirming validity of the presentation information (col. 16, lines 10-15, lines 40-65, col. 17, lines 35-60); analyzed electronic advertisement supply means for analyzing for the user advertisements information and supplying advertisement information having contents reflecting the analysis (profile information, col. 18, lines 55-60).

Additionally, Goldhaber further discloses that advertising information has unique identifiers via indexes (Fig. 15, item 466; Fig. 11a, item 182) and that content is uniquely identified via indexes on the user's computer (col 8, lines 40-50).

Goldhaber further discloses that advertising information is saved to the user computer (col 24, lines 45-50)

Goldhaber discloses that only nonduplicate advertisement information is saved on the user computer (Fig. 15; col 20, lines 10-26; col 14, lines 59-67).

Note that the offers to sell something cited (col 20, lines 10-26) above are functionally equivalent to an advertisement.

Furthermore, in the above citation (col 16, lines 24-41), note that Goldhaber tracks what advertisement the user views, that advertisements are stored on the user's computer

Art Unit: 3622

(advertisement receiving apparatus) when the user decides to view an ad, and that only ads that the user has not already viewed are presented to the user as possible ads for viewing. Hence, Godlhaber compares advertisement identifying information to ensure that no duplicate ads are saved to the users computer.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. The feature added to Independent claim 1, "when said identifying information does not match said identifying information...", does not specify where the comparison of matching identifiers takes place. Hence, the comparison can take place at the advertisement receiving apparatus or at another location, in this case, such as Goldhaber's attention brokerage server.

Goldhaber further discloses that said benefits are updated according the number of times or a time period said advertisement information is presented (col 30, lines 4-8).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210).

Goldhaber substantially teaches the invention as discussed above.

Goldhaber further discloses response data representing reception of the advertisement (col 5, line 64-col 6, line 3; col 11, lines 32-44; col 16, lines 7-17; col 23, lines 1-5).

Goldhaber further discloses that advertising information has unique identifiers via indexes (Fig. 15, item 466; Fig. 11a, item 182) and that content is uniquely identified via indexes on the user's computer (col 8, lines 40-50).

Goldhaber further discloses tracking advertisement utilization and reception (Fig. 15; col 20, lines 10-26; col 14, lines 59-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber can utilize index or other advertisement identifiers to identify advertisement during interactions. One would have been motivated to do this in order to provide a way of tracking advertisements.

It also would have been obvious to have ended advertising distribution when a calculated number reached a predetermined number since this would have limited the amount of money spent on advertising.

It also would have been obvious to have limited the advertisement distribution to an area since Goldhaber is interested in reaching the most receptive consumers and since demographic information is included in the consumer profile.

6. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (5,794,210) in view of Sharony (5,742,593).

Goldhaber discloses the apparatus above.

Goldhaber further discloses multiple communications channels and networks (col 1, lines 20-25; col 3, lines 40-50; col 4, lines 13-20).

Goldhaber does not explicitly disclose that a channel is only for advertising information.

However, Sharony further discloses wireless communications (col 1, lines 8-15) and means for delivering advertising comprising a dedicated channel independent of other channels used for normal communications by the mobile communication device (col 5, lines 28-44).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber's channel for receiving advertising can be a dedicated advertising channel. One would have been motivated to do this in order to provide fast or reliable communication of advertising information.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 3-5, 8-15 have been considered but are not found persuasive. New claims 16-20 are rejected above.

Also, Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety and the combination of the prior art in its entirety that is being referred to.

On page 15 of the Applicant's Amendment dated 6/28/04, Applicant states, "But amended claim 1 is quite different. . .that does not match identifying information that has previously been stored."

However, Goldhaber further discloses that advertising information has unique identifiers via indexes (Fig. 15, item 466; Fig. 11a, item 182) and that content is uniquely identified via indexes on the user's computer (col 8, lines 40-50).

Goldhaber further discloses that advertising information is saved to the user computer (col 24, lines 45-50)

Goldhaber discloses that only nonduplicate advertisement information is saved on the user computer (Fig. 15; col 20, lines 10-26; col 14, lines 59-67).

Note that the offers to sell something cited (col 20, lines 10-26) above are functionally equivalent to an advertisement.

Furthermore, in the above citation (col 16, lines 24-41), note that Goldhaber tracks what advertisement the user views, that advertisements are stored on the user's computer (advertisement receiving apparatus) when the user decides to view an ad, and that only ads that the user has not already viewed are presented to the user as possible ads for viewing. Hence, Goldhaber compares advertisement identifying information to ensure that no duplicate ads are saved to the user's computer.

Examiner further notes that it is the Applicant's claims as stated in the Applicant's claims that are being rejected with the prior art. The feature added to Independent claim 1, "when said identifying information does not match said identifying information...", does not specify where the comparison of matching identifiers takes place. Hence, the comparison can take place at the advertisement receiving apparatus or at another location, in this case, such as Goldhaber's attention brokerage server.

On page 17 of the Applicant's Amendment dated 6/28/04, Applicant states, "but there is no evidence of this other than speculation. . .". However, please see the U.S.C. 103(a) rejection above with further citations.

However, Goldhaber further discloses response data representing reception of the advertisement (col 5, line 64-col 6, line 3; col 11, lines 32-44; col 16, lines 7-17; col 23, lines 1-5).

Goldhaber further discloses that advertising information has unique identifiers via indexes (Fig. 15, item 466; Fig. 11a, item 182) and that content is uniquely identified via indexes on the user's computer (col 8, lines 40-50).

Goldhaber further discloses tracking advertisement utilization and reception (Fig. 15; col 20, lines 10-26; col 14, lines 59-67).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Goldhaber can utilize index or other advertisement identifiers to identify advertisement during interactions. One would have been motivated to do this in order to provide a way of tracking advertisements.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Angles (5,933,811) discloses storing advertising and identifiers on a user computer.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AD

9/10/04

JAMES W. MYHRE
PRIMARY EXAMINER